



514413-3900  
PATENT

1638  
H-9  
Electrol

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

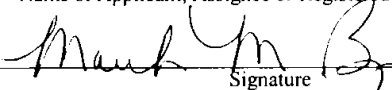
Applicant : Schewe et al  
Serial No. : 10/038,224  
Filed : October 19, 2001  
For : MONOCOTYLEDON PLANT CELLS AND PLANTS  
WHICH SYNTHESISE MODIFIED STARCH  
Examiner : David T. Fox  
Group Art Unit : 1638

745 Fifth Avenue  
New York, New York 10151

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Assistant Commissioner for Patents, Washington, DC 20231, on the date shown below.

Marilyn Matthes Brogan, Reg. No. 31,223

\_\_\_\_\_  
Name of Applicant, Assignee or Registered Representative

  
\_\_\_\_\_  
Signature

February 19, 2002

\_\_\_\_\_  
Date of Signature

**RESPONSE TO OFFICE ACTION WITH REQUEST FOR  
WITHDRAWAL OF RESTRICTION REQUIREMENT**

Assistant Commissioner for Patents  
Washington, D.C. 20231

Sir:

This is in response to the Office Action mailed on January 23, 2003, setting a one month term for reply.

The Office Action required election from among:

Group I: Claims 1-17 and 27, drawn to monocotyledonous cells and plants transformed with a gene encoding an R1 protein, methods of making the plants, and methods of using the plants to produce starch with altered properties, classified in class 800, subclass 284;

- Group II: Claims 18-26, drawn to a starch, classified in class 536, subclass 102; and  
Group III: Claims 28-33, drawn to a method of using starch to produce flour and foodstuffs, classified in class 426, subclass 549.

Group I, claims 1-17 and 27, is elected with traverse for further examination in this application. Applicants retain the right to file divisional applications to non-elected subject matter. Reconsideration and withdrawal of the restriction requirement are requested in view of the remarks herein.

The Office Action argues that the Groups I and II are related, but distinct, because the starch of Group II can be made by a different process than that of Group I. The Office Action further states that Groups II and III are related as product and process of use, but are distinct in that the product of Group II can be used in a materially different process than that of Group III.

Under 35 USC §121, "two or more independent and distinct inventions ... in one application may ... be restricted to one of the inventions." Inventions are "independent" if there is no distinct relationship between two or more subjects disclosed." MPEP 802.01. The term "distinct" means that "two or more subjects as disclosed are related ... but are capable of separate manufacture, use or sale as claimed." MPEP 802.01. Nonetheless, even with patentably distinct inventions, restriction is not required unless one of the following reasons appear (MPEP 808.02): separate classification; separate status in the art; or different field of search.

Under Patent Office procedures, "[i]f the search and examination of an entire application can be made without serious burden, the Examiner must examine it on the merits, even though it includes claims to distinct or independent inventions." MPEP 803 (emphasis added).

37 CFR §1.141(b) states, "the process of using [a claimed product] may be joined with the claims directed to the product and the process of making the product even though a showing of distinctiveness between the product and the process of using the product can be made."

A search of any one Group would involve such interrelated art, that an examination of the entire application can be made without undue burden on the Examiner. Therefore, reconsideration and withdrawal of the Requirement for Restriction is requested. Early and favorable examination on the merits of this application are earnestly solicited.

If any fees are determined to be due for entry and consideration of this paper, the Assistant Commissioner is authorized to charge any fee or credit any overpayment to Deposit Account No. 50-0320.

Respectfully submitted,

FROMMER LAWRENCE & HAUG LLP  
Attorneys for Applicants

By: 

Marilyn Matthes Brogan  
Registration No. 31,223  
(212) 588-0800